

REMARKS

This application has been reviewed in light of the Office action dated November 27, 2006. Claims 1-18 are pending in the application. By the present amendment, claims 1, 9, 17, and 18 have been amended. Claims 2-4 and 10-12 have been cancelled, without prejudice. No new matter has been added. The Examiner's reconsideration of the rejection in view of the amendment and the following remarks is respectfully requested.

By the Office Action, the Examiner objected to the claim 18. Claim 18 has been amended to address the Examiner's issues. Reconsideration is respectfully requested.

It is to be noted that Claim 1 and 9 have been amended to respectively include the limitations of Claims 2-4 and 10-12. Accordingly, no new matter has been introduced WHATSOEVER, into the pending claims.

By the Office Action, claims 1-3, 7, 9-11, 15, and 17 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 7,069,308 to Abrams (hereinafter "Abrams"). Claims 4 and 12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Abrams as applied respectively to claim 3 and 11, and further in view of U.S. Patent No. 6,549,912 to Chen (hereinafter "Chen"). Claims 5, 8, 13, and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Abrams as applied respectively to claim 1 and 9, and further in view of U.S. Patent Publication No. 2005/0015432 to Cohen (hereinafter "Cohen"). Claims 6 and 14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Abrams as applied respectively to claim 1 and 9, and further in view of U.S. Patent Publication No. 2004/0148346 to Weaver et al. (hereinafter "Weaver"). Claim 18 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Abrams in view of U.S. Patent Publication No. 2003/0083898 to Wick

et al. (hereinafter "Wick") in view of U.S. Patent Publication No. 2003/0147369 to Singh et al (hereinafter "Singh").

As noted above, claims 2-4 and 10-12 have been cancelled.

It is respectfully asserted that none of the cited references teach or suggest "providing said social relationship collection object as a user list; associating said user list with a meta-tag; and automatically modifying the meta-tag when retrieved by said second user", as now recited in amended claims 1 and 9.

Moreover, it is respectfully asserted that none of the cited references teach or suggest, "wherein said at least one processor further provides said social relationship collection object as a user list, associates said user list with a meta-tag, and automatically modifies the meta-tag when retrieved by said second user", as now recited in amended claim 17.

As noted above, independent claims 1, 9, and 17 have been amended. The limitations now recited in claims 1 and 9 were directly taken from previously pending, but currently cancelled, claims 2-4 and 10-12, respectively. It is to be noted that Abrams was cited against Claims 1-3 and 9-11, and Chen was cited against Claims 4 and 12.

It will be argued herein that none of the cited references, either taken singly or in any combination, teach or suggest the above recited limitations of Claims 1, 9, and 17, particularly the limitations previously recited in Claims 4 and 12. Thereafter, it will be argued that Chen is non-analogous art and is, thus, not applicable in a rejection of the pending claims.

Accordingly, with respect to Claims 1, 9, and 17, the social relationship collection object is provided as a user list that is associated with a meta tag, where the meta tag

is automatically modified when retrieved by the second user. Thus, the meta tag ultimately corresponds to the social relationship collection object.

In contrast, in applying Chen against previous claims 4 and 12, the Examiner reasoned that “when the file in Chen is rented the meta-tag is automatically updated; the concept of renting the file is considered to be analogous to the concept of sharing a user file) in order to provide the user a tool for customization of the user list” (Office Action, p. 7). In Chen, the file disclosed is a loyalty file.

However, the renting of a loyalty file has nothing to do with a social relationship collection object or a user list relating to a social relationship collection object, let alone a retrieval of the same. For example, a loyalty program pertains to “reward[ing] customers for frequent purchase of the business’s products or services” (Chen, col. 1, lines 12-14). A loyalty file is a file that allows “the cardholder possessing card 104 [to be] able to take advantage of the merchant’s loyalty program using loyalty file 106 on card 104 that has just been assigned” (Chen, col. 7, lines 1-3). Clearly, a loyalty program and/or loyalty file for a smart card has nothing to do with a social relationship collection object, but rather relates to business. As a common saying goes “business and pleasure (relationships) do NOT mix”.

Further, the rental of a file in Chen does not pertain to the retrieving of a meta tag as recited in claims 1, 9, and 17.

Accordingly, Chen does not teach or suggest “providing said social relationship collection object as a user list; associating said user list with a meta-tag; and automatically modifying the meta-tag when retrieved by said second user”, as recited in claims 1, 9, and 17. That is, Chen does not teach or suggest automatically updating a meta tag associated with a

social relationship object provided as a user list upon a retrieval of the meta tag, as essentially recited in Claims 1, 9, and 17.

Moreover, none of the other cited references cure the deficiencies of Chen, and are silent with respect to the above recited limitations of Claims 1, 9, and 17. Thus, none of the cited references, either taken singly or in any combination, teach or suggest the preceding limitations recited above in claims 1, 9, and 17.

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art” (MPEP §2143.03, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)).

It will now be argued that Chen is non-analogous art.

While the instant application is directed to social network surfing (Applicants’ specification, Title), Chen is disparately directed to “loyalty file structure for smart card” (Chen, Title).

“In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned”, MPEP §2141(a), citing *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) (“A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.”); *Wang Laboratories Inc. v. Toshiba Corp.*,

993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); and *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved).

Here, the field of endeavor of Chen is disparate and unrelated to that of the Applicants. For example, the instant application is related to social network surfing (Applicants' specification, Title). In contrast, Chen relates to the "implementation of a value-added file structure on smart cards" (Chen, Field of the Invention). A smart card, as per Chen, has nothing to do with social network surfing as per the instant application. Accordingly, the field of invention of Chen differs from that of the Applicants.

Moreover, the instant application is directed to the problem of sharing social relationships collections (Applicants' specification, para. [0008]). In contrast, Chen is directed to the problem of being able to "allow loyalty operators to enroll customers having smart cards from any issuer in that loyalty operator's loyalty program without the need for a prearranged, fixed relationship with any issuer" and further to "allow "an issuer to be able to generate revenue from loyalty programs implemented on smart cards issued by the issuer, yet relieve the issuer from having to negotiate agreements or from having to design custom loyalty file structures" and also to "allow a loyalty operator to flexibly define their own loyalty program and to implement loyalty application software to its own liking" (Chen, col. 2, lines 15-25). Thus, while the instant application is directed to the problems of sharing social relationships collections, Chen is disparately directed to the problems faced by customers and issuers of

smart cards with respect to loyalty programs for using the smart cards. Accordingly, the problems to which the instant application is directed are quite different than the problems to which Chen is directed.

Further, given the differences in endeavor, problems to be solved, and matter in which they respectively deal with, the subject matter of Chen would NOT have commended itself to an inventor's attention in considering the problems to which the instant application is directed.

Accordingly, Chen is non-analogous art with respect to the instant application, and the pending claims thereof, and its use against the pending claims is improper.

Additionally, it is respectfully asserted that none of the cited references, either taken singly or in any combination, teach or suggest "determining the number of users in the second organization that would be using the social relationship collection objects of the first organization", as recited in Claim 18.

It will be argued herein that none of the cited references, either taken singly or in any combination, teach or suggest the above recited limitations of Claim 18. Thereafter, it will be argued that Wick, which was applied against the above recited limitations, is non-analogous art and is, thus, not applicable in a rejection of the pending claims.

Claim 18 does not simply recite determining the number of users in the second organization, but rather "determining the number of users in the second organization that would be using the social relationship collection objects of the first organization". In contrast, Wick simply discloses determining the "number of staff member contacts within a business unit" (Wick, para. [0045]). Thus, Wick does not teach or suggest, that is Wick does not further

modify and/or limit his teaching regarding the number of users not only in the second organization, but those in that organization that would be using the social relationship collection objects of the first organization as explicitly recited in claim 18.

Accordingly, Wick does not teach or suggest the above recited limitations of claims 18. Further, none of the remaining references cure the deficiencies of Wick, and are silent with respect to the above recited limitations of claim 18.

Thus, none of the cited references, either taken singly or in any combination, teach or suggest the preceding limitations recited above in claim 18.

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art” (MPEP §2143.03, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)).

It will now be argued that Wick is non-analogous art.

As noted above with respect to Chen and Claims 1, 9, and 17, “[i]n order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned”, MPEP §2141(a), citing *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) (“A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.”); *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993);

and *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved).

Here, the field of endeavor of Wick is disparate and unrelated to that of the Applicants. For example, the instant application is related to social network surfing (Applicants' specification, Title). In contrast, Wick is directed to a "system and method for monitoring intellectual capital" (Wick, Title, and Technical Field of the Invention). Intellectual capital as per Wick has nothing to do with social network surfing, as per the instant application. Accordingly, the field of invention of Wick differs from that of the Applicants.

Moreover, the instant application is directed to the problem of sharing social relationships collections (Applicants' specification, para. [0008]). In contrast, Wick is directed to the problem that intellectual capital, which is a significant percentage of a business's market value, is typically undefined and unmanaged" (Wick, para. [0004]). Thus, while the instant application is directed to the problems of sharing social relationships collections, Wick is disparately directed to the problem of defining and managing intellectual capital of a business. Accordingly, the problems to which the instant application is directed are quite different than the problems to which Wick is directed.

Further, given the differences in endeavor, problems to be solved, and matter in which they respectively deal with, the subject matter of Wick would NOT have commended itself to an inventor's attention in considering the problems to which the instant application is directed.

Accordingly, reconsideration of the rejections of Claims 1, 9, 17, and 18, is earnestly solicited.

If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious" (MPEP §2143.03, citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

Claims 5-8 depend from Claim 1 and thus include all the limitations of Claim 1. Claims 13-16 depend from Claim 9 and thus include all the limitations of Claim 9. Accordingly, Claims 5-8 and 13-16 are patentably distinct and non-obvious over the cited reference for at least the reasons set forth above with respect to Claims 1 and 9, respectively.

In view of the foregoing amendments and remarks, it is respectfully submitted that all the claims now pending in the application are in condition for allowance. Early and favorable reconsideration of the case is respectfully requested.

It is believed that no additional fees or charges are currently due. However, in the event that any additional fees or charges are required at this time in connection with the application, they may be charged to applicant's IBM Deposit Account No. 50-0510.

Respectfully submitted,

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